REMARKS

The pending Office Action addresses and rejects claims 40-89.

CLAIM OBJECTIONS

The Examiner objects to claims 42-44, 47-49, 52-55, 58-59, 62-68, 71-72, 74-76, and 80-89 as having improper antecedent basis. Applicants amend these claims in accordance with the Examiner's suggestion, thereby obviating the basis for the objection.

REJECTIONS UNDER 35 U.S.C. 102

Claims 40, 41, 45, 46, 56, 57, 61, 69, 70, 73, and 77 are rejected as being anticipated by U.S. Patent No. 5,483,586 of Sussman.

Claim 40 recites a method of establishing a communications call, which comprises enabling an A party to select a B party from a database using an interactive device connected to a public network, where the public network comprises an Internet messaging network. The method further calls for utilizing the Internet messaging network to access called address data for the B party from a public directory of said public network in response to selecting the B party, and sending the called address data for the B party and calling address data for the A party to a connection module of said public network. A call can then be established between the A and B parties over the public network using the connection module and the called and calling address data.

In response to the Examiner's assertion that Applicants are silent as to how the claimed method is different from the method as taught by Sussman, Applicants herein outline the most prominent differences. Sussman does not teach utilizing an Internet messaging network to access called address data for a B party from a public directory of a public network in response to selecting the B party. Instead, Sussman discloses a method whereby directories are downloaded from a central database and are saved to a subscriber's *local* device. The subscriber then searches the *locally* saved directories for another party's name, number, and other information. Once the other party's information is found within the locally saved directory, the subscriber can direct the local device to call the other party.

In particular, Sussman teaches that directory data is periodically downloaded from a Central On-line Database System to a subscriber's local device and stored in the subscriber's *local hard disk memory*. Sussman states:

> Directory Memory 9 contains all of the subscriber's on-line telephone directories, that are downloaded from the Central On-line Database System 3....This memory can be implemented using small hard disk devices...The preferred embodiment of the current invention uses a hard disk storage memory device. The directories can be installed at the time of purchase. For example, if the user buys the invention from a store, then the manufacturer of the invention can provide a system, e.g., a CD-ROM...so that the user's selection of telephone directory can be directly down loaded into the invention without having to be connected to the CCTSN 4.

See col. 4, lines 12-37 of Sussman. This passage teaches that a subscriber's chosen directories are downloaded to the subscriber's *local memory*, such as a hard disk storage device. Sussman refers to these downloaded and locally stored directories as "Directory Memory 9." In further support of this concept, this passage also teaches that initial directory data can be placed on a subscriber's local device through the use of a CD-ROM. The use of a CD-ROM allows the subscriber to transfer initial directory data from the CD-ROM directly to the Directory Memory 9, thereby giving the user full access to all directory data and information *without ever having to connect to another server or system*, including the Central On-line Database System 3 through the Common Carrier Telecommunications Switching Network (CCTSN) 4.

Accordingly, all directory data is stored in local memory and a subscriber's local device accesses the CCTSN 4 to connect to the Central On-line Database System 3 only to receive periodically updated directory information. When a subscriber wishes to find another party's call data, the subscriber enters search terms into its *local* device, which then searches the directory information stored in the local memory. Hence, unlike claim 40, the subscriber in Sussman does not utilize an Internet messaging network of a public network to obtain called address data of a party from a public directory of the public network in response to the selection of that party. Rather, in Sussman, the subscriber only accesses the directory information stored in its local device.

As noted in Applicants' previous response, another difference between the method of Sussman and the claimed method is that Sussman employs a conventional switching network (i.e., CCTSN), and not an Internet messaging network, for transmitting the directory information to a subscriber. In response to this assertion, the Examiner points to two passages in Sussman to allege that it utilizes an Internet messaging network to transfer data to a subscriber. Applicants respectfully disagree for the following reasons.

First, the Examiner points to col. 5, lines 50-55 of Sussman as disclosing that a user can access a telephone subscribers list in on-line directories. The passage referred to by the Examiner states:

> This circuit provides the means for the user to access all telephone subscribers listed in the on-line directories 9 and 10, as well as the Central On-line Database System 3. The subscriber can direct the current invention to dial any number listed in the on-line directories 9 and 10 and to notify the user when the dialed party answers the phone.

The Examiner appears to be assuming that the terminology "on-line" in this passage must be related to the use of the Internet. However, considering this passage in the context of the rest of Sussman leads one to conclude that the "on-line" terminology does not relate to the use of the Internet. In particular, when explaining a preferred embodiment of the invention, Sussman gives a definition to "online directories" as being "down-loaded, read-only directories." Sussman states,

> [b]ecause of the constant changes in subscribers in the Central Online Database System 3, the current invention's preferred embodiment has implemented various levels of frequency at which the subscriber could elect to receive updated *online (downloaded, read-only) directories.*

See col. 2, lines 51-55 of Sussman, emphasis added. As noted in detail above, the data from the Central Online Database System 3 is downloaded to memory called Directory Memory 9 in a subscriber's *private local device.* Additionally, a subscriber's personally inputted directory data is stored in the user directory 10. Thus, Sussman uses the term "on-line" to refer to down-loaded, read-only directory information that is stored electronically in the user's local hard disk memory, or to information that is inputted personally by the subscriber.

Second, the Examiner refers to col. 6, lines 56-59 of Sussman, which states, "[t]hese user lists, and the relevant subscriber information, can be down (or up loaded) loaded into a PDO (or a Computer)

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via the modem 13 interface." Again, if this passage is read in context, it will be seen that Sussman is disclosing the properties of the *user directory 10*. The user directory 10 is a directory that is made solely by the user and that includes the user's personal phone numbers and information for friends, family, and/or business contacts. In the passage referred to by the Examiner, Sussman indicates that a user's personal user directory 10 can be uploaded or downloaded to his personal PDO or personal computer. Even if the user uses the Internet to accomplish this task (which Sussman does not even mention), it has no bearing on employing an Internet messaging network for transmitting directory information to a subscriber.

Moreover, even if one were to agree with the Examiner, *arguendo*, that Sussman employs the Internet for downloading directory data from the service provider to the subscriber, its method differs fundamentally from that recited in claim 40. In particular, in Sussman, the user searches the *downloaded local* directory data for a party's telephone number, rather than accessing the central database. In other words, in Sussman, in response to each user's search query, the service provider's central directory is not accessed. Rather, a search of the *downloaded directory data* is performed. In contrast, claim 40 recites that in response to the selection of the B party, the Internet messaging network is utilized to access the called address data for the B party. As such, the claimed method provides a number of advantages. For example, it obviates the need to store a large quantity of data on the user's side, eliminates the need for tedious downloads to each user and allows access to real-time (most current) address data.

For all of these reasons, claim 40 distinguishes patentably over Sussman.

Similar reasoning applies to establish that claims 41, 45, 46, 56, 57, 61, 69, 70, 73, and 77 distinguish patentably over Sussman.

Rejections Under 35 U.S.C. 103

Claims 40, 41, 42/40, 42/41, 43-46, 47/40, 47/41, 47/45, 47/46, 48, 49, 56-58, 59/56, 59/57, 60, 61, 62/60, 62/61, 63, 64/60, 65/60, 66/61, 67/60, 67/61, 68-71, 72/69, 72/70, 73-87, 88/40, 88/41, 88/45, 88/46, 88/73, 89/40, 89/41, 89/45, 89/46, and 89/73 are rejected as being unpatentable over U.S. Patent No. 5,884,032 of Bateman in view of Sussman.

Bateman is directed to methods and systems for automatically providing a telephone connection between a customer and an Automatic Call Distribution (ACD) agent. In a typical session, a customer utilizes a browser to access a web server of an organization to view HTML pages containing information regarding the organization's products and services. The customer can choose a "Live Help" option provided within a viewed HTML page to prompt a HTML form to pop up. The pop-up HTML form asks the customer for a telephone number at which the customer can be reached. Further, the URL of the page that the customer was viewing is automatically entered in the form. The customer's calling information is sent to a HOTLIST database that feeds an outbound dialing system. The agent can view the HTML page associated with the customer's URL before or while a call is automatically made to connect the agent to the customer.

In Bateman, a customer does not select a particular agent from a database. Rather, the customer submits an HTML form to the call center in which the customer's calling information is provided, and the outbound dialing system, which maintains a HOTLIST of customers to be called, selects an agent for calling the customer. Nonetheless, the Examiner continues to assert that it would have been obvious to one of ordinary skill in the art to modify Bateman with Sussman to select a particular agent. The Examiner indicates that the motivation for the modification is "to get a particular agent who can assist him instead of waiting for a certain period of time in a queue."

Bateman indicates that a purpose of its invention is to provide a more efficient way of dealing with multiple customers desiring to speak with a live customer service agent. Bateman states many conventional systems in which multiple customers contact an organization's customer service department at once are inefficient as they require the customers to wait on hold for extended periods of time to reach a customer service agent that may or may not be the appropriate agent for their particular question or problem. In particular, Bateman states:

> Thus, there are at least two disadvantages of current systems. First, the need for the customer to physically record and dial the 800 number is a disincentive to making the call. Secondly, the likelihood of waiting in long ACD queues is also a disincentive to making the call. ... Furthermore,...a more accurate initial setup, which for example incorporates the specifics of the customer's queries, is not possible [in the prior art].

See col. 1, lines 40-46 of Bateman.

Bateman's solution to these problems is a system that allows the ACD agents to determine how and when to speak with customers, thereby preventing customers from waiting on hold and from reaching agents not appropriate for their particular inquiry. Bateman teaches that a main feature of his invention is the ability to link and integrate customers and *appropriate* ACD agents to provide assistance. *See col. 2, lines 60-65 of Bateman*. Bateman later explains that an agent's workstation is set up to preview the HTML page associated with the caller's URL before or while the agent is contacting the customer. This allows the agent to become familiar with the customer's inquiry *before* speaking with the customer.

A modification of Bateman's system with the teachings of Sussman as suggested by the Examiner would, however, thwart the purpose of the system as taught by Bateman. In fact, such a modification would return the system of Bateman to an inefficient system of the type that Bateman disparages. In particular, in such a modified system the customer would have no way of knowing whether the agent it chooses is appropriate for its inquiry. In addition, there is no guarantee that a particular agent selected by the customer would be available at the time the customer selects that agent. Further, such a modification would not allow an agent to consider a customer's inquiry off-line and call back the customer only when the agent can answer the customer's question.

Thus, claim 40 distinguishes patentably over the cited art. Similar reasoning applies to establish that independent claims 41, 45, 46, and 49 are also patentable. Further, each of the claims 42, 43, 44, 47, 48, and 49 depends on at least one of these claims, and hence is also patentable.

With regard to claim 56, neither Bateman nor Sussman teaches an interface stored on an interactive device connected to a public network, which includes code for allowing an A party to select a B party from displayed B party data as well as code for transmitting to the public network party data corresponding to the selected B party and A party, where the public network accesses called address data for the B party in a public directory by utilizing an Internet messaging network. In particular, in Bateman, the customer does not select an agent. Further, in Sussman, the subscriber searches the *downloaded* directory for a party's telephone number, rather than selecting the party via an interactive display device and sending the party data, via the Internet, to a public directory such that the public directory would access the party's telephone number.

In addition, there is no reason to modify Bateman based on teachings of Sussman. The Examiner argues that the motivation for the modification is to allow a customer to select a particular agent from a directory instead of waiting in a queue. As an initial matter, in Bateman, a customer does not wait on a queue. Rather, the system can provide the customer with a time at which an agent would contact her. Further, as explained in detail above in relation to claim 40, allowing a customer to choose a customer service agent will thwart the purpose of Bateman. The efficiency of allowing the appropriate customer service agent to contact the customer, as proposed by Bateman, will have been lost.

Hence, claim 56 is believed to be patentable over the combined teachings of Bateman and Sussman.

In Paragraph 13, the Office Action rejects claims 40, 41, 45, 46, 50, 51, 56, 57, 60, 61, 69, 70, 73 and 77 as being unpatentable over U.S. Patent No. 4,979,206 of Padden in view of Sussman. Applicants respectfully traverse the rejections for the following reasons.

Neither Padden nor Sussman teaches utilizing *Internet messaging network* to access the called address data of a party from a public directory of the network in response to the selection of that party by another party. In particular, the voice and data switching network in Padden is not an Internet messaging network. Nor is the CCTSN switch of Sussman, as discussed above. Moreover, in Sussman, in response to a search query from the subscriber, a searched party's telephone number is looked up in the subscriber's *local* directory memory that had been previously downloaded from the central database; it is not accessed in the central database via the Internet, or for that matter via CCTSN. In contrast, claim 40 recites that in response to selecting the B party, the Internet messaging network is utilized to access called address data for the B party from a public directory of that network.

Thus, claim 40 distinguishes patentably over the combined teachings of Padden and Sussman. Similar reasoning applies to establish that independent claims 41, 45, 46 are also patentable over the cited art.

With regard to claim 50, Padden does not display a B party from a database to an A party. Further, Sussman does not provide a link that can be activated to send party data corresponding to a party selected by the subscriber from a display to a public network, where the public network accesses

called address data of the B party in a public directory via an Internet messaging network. In fact, as noted above, in Sussman, the subscriber utilizes the directory data that has already been downloaded to its local directory memory to search for a party's telephone number – it does not send the party's information to the central database to obtain its telephone number.

Hence, claim 50 distinguishes patentably over cited art. Similar reasoning applies to establish that claims 51, 56, 57, 60, 61, 69, 70, 73, and 77 are also patentable.

CONCLUSION

In view of the above amendments and remarks, Applicants respectfully request reconsideration and allowance of the application. The Examiner is invited to call the undersigned at (617) 439-2514 if there are any questions.

Respectfully submitted,

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